

TTAB

Docket No. 874-003

TRADEMARK

AMENDMENT TRANSMITTAL LETTER

In re Application of: Shammass

Serial No. 77/758,863

Examining Attorney: Benjamin

Filing Date: 6/12/09

Law Office: 110

Mark: PROBIOTIC

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

In connection with the above-referenced trademark application,
please find the following:

- 1) Reply Brief

The Director is hereby authorized to charge the required fee, any
deficiency, or credit any overpayment, to Deposit Account No. 50-3946.

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Respectfully submitted,


Sandra Lee Lipkin

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02-14-2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:)	Trademark Attorney
Milo Shammass)	Sara N. Benjamin
)	Law Office: 110
Serial No. 77/758,863)	
Filed: June 12, 2009)	Docket No.: 874-003
)	
Mark: PROBIOTIC)	Date: February 6, 2012

APPLICANT'S REPLY BRIEF

1.0 Introduction.

Pursuant to the Notice of Appeal and the Appeal Brief previously submitted, the Applicant has appealed the Trademark Examining Attorney's refusal to register Applicant's mark PROBIOTIC for soils and fertilizers on the Section 2(e)(1) ground that it is generic or in the alternative that it is merely descriptive. This Reply is submitted in response to the Examining Attorney's Appeal Brief, mailed December 15, 2011.

2.0 Relevant Facts.

Applicant has applied for the mark PROBIOTIC for use with soils and fertilizers based on in-use in commerce and interstate commerce at the time the application was filed. The record shows that Applicant has been using the mark in interstate commerce since at least July 12, 2000. The record also shows that the Applicant conceived of the use of the word with regard to his goods as early as 1992 when he commissioned the design of a logo. The record also shows that Applicant owns a

California registration for the mark with use of the cited goods that was granted in 2001.

Prior to Applicant's use of the mark for the goods cited, the word was not commonplace at all and was not associated in the public's eye with soils and fertilizers. Through continued use and goodwill, the mark has now become a recognized mark with fertilizers and soils produced by the Applicant. Evidence of record shows that this association originated with the Applicant's use.

3.0 Responses to the Examining Attorney's Arguments.

3.1 Objection to New Evidence

The Examiner objects to new evidence submitted at the time of appeal, i.e., the Registration 3,895,671 for Applicant's related mark PREBIOTIC. Applicant does not dispute that this is not part of the record. However, Applicant introduced this evidence for the sake of argument against the generic rejection. This is not a third-party registration as noted by the Examiner in that it is owned by the Applicant and is for the same goods as the subject mark. It is included in the argument as relevant toward the discussion of how such a mark, however similar, was not deemed generic at the time of first use.

3.2 The Proposed Mark is not Generic for the Identified Goods

The Examiner finds the proposed mark to be generic for the identified goods because the Encarta® World English Dictionary defines "probiotic" as a "substance containing beneficial organisms" and because

Applicant's website defines its fertilizer products as containing "beneficial soil bacteria" and/or "beneficial soil microbes and mycorrhizae." The Examiner asserts that a word or term that is the name of a key ingredient, characteristic or feature of the goods can be generic for those goods and thus, incapable of distinguishing source.

Applicant disputes that the definition provided by the Examiner is the prevailing one that is associated with the word. As evidenced by the Wikipedia entry, which is an open source encyclopedia that is subject to correction by any member of the public and therefore reflects the commonly held definitions and understandings of topics. The word is commonly associated as of the time of this writing with the guts of living organisms and not fertilizers. The previously submitted Wikipedia entry defines PROBIOTIC as "live microorganisms which when administered in adequate amounts confer a health benefit on the host." There is no mention, as of the date of April 5, 2011, of the use of probiotics as fertilizer, despite its popularity in the industry that was originated by Applicant.

The Examiner asserts that Applicant is mistaken in the belief that the host organism in the definition submitted by Applicant that "[p]robiotics are live microorganisms thought to be beneficial to the host organism" that the host organism must be a human being or even an animal at all. The Examiner argues that in this case the "host" is the

plant that receives the live microorganisms through Applicant's fertilizer products.

Applicant disagrees with this assertion. While a "host" is an animal or plant that provides beneficial nutrition for a parasite, in this context, to argue that the plants receiving the fertilizer are acting as said hosts is a convoluted association not likely to be made in the minds of most consumers.

The Examiner further argues that the affidavit submitted by Dr. Amaranthus uses the term in a generic fashion as evidence that it is generic.

Applicant argues that the previously submitted statement from Mike Amaranthus should not be read as an opportunity to find a generic use of the word. Dr. Amaranthus' statement was provided as evidence that the prior to Applicant's use of the word for his goods, it was not associated with said goods.

Applicant strongly and respectfully re-asserts that the relevant public does NOT understand the designation of the word "probiotic" to refer to the class or genus of goods at issue, which are soils and fertilizers. The use of the word to describe live organisms in soils and fertilizers is not considered generic in that the general public does not relate organisms described in oral supplements designed to aid in the intestinal health of living organisms with additives to soils and fertilizers.

Applicant again refers to Exhibit H which is an internet print-out of Merriam-Webster's dictionary definition of probiotic, which is "a preparation (as a dietary supplement) containing live bacteria (as lactobacilli) that is taken orally to restore beneficial bacteria to the body; also a bacterium of such a preparation."

As this definition demonstrates, as far as the general public is concerned, the word probiotic refers to an orally taken supplement to the body to restore beneficial bacteria. The word-goods association made by the Examiner is not made by the general public upon hearing the word "probiotic." Furthermore, there is no correlation to any organisms referred to as probiotic that promote intestinal health to any organisms added to soils and fertilizers for the creation of more fertile medium in which to grow flora.

As the Wikipedia entry states, the word "probiotic" is associated with oral supplements that provide health improvements for the alleviation of chronic intestinal inflammatory disease and other disorders of the gut. All of this leads to the understanding of the generic use of the word "probiotic" to refer the oral ingestion of organisms by a host organism that has both a mouth and a gut. Plants are generally not thought of to have a "gut" by the general public.

Applicant's use of the word "probiotic" in his soils and fertilizers involves no host organism with either a mouth or a gut. Accordingly, the relevant public would not associate the word "probiotic" as it is generally

understood to have anything at all to do with soils and fertilizers. Hence, since “probiotic” as understood by the general public involves the ingestion of living organisms by a host with a mouth and a gut, the use of the word with regard to soils and fertilizers is neither generic or descriptive since it does not describe applicant’s goods in any way.

3.3 Because the term PROBIOTIC is widely viewed by the consuming public as generic with regard to goods DISTINCT FROM Applicant’s goods, it is not generic.

The Examiner cites proof of the use of term by other products of similar goods as proof that the term is generic for Applicant’s goods.

Applicant repeats his argument that while the term has been used for similar goods, none of this use pre-dates Applicant’s first use. Furthermore, since the general public, as evidenced by the Wikipedia entry, does not associate the term with Applicant’s goods, it is not generic for said goods.

3.4 Since Applicant was the first user of the term PROBIOTIC with regard to fertilizer, it is not generic.

The Examiner asserts that because Applicant was the first to use the word with relation to his goods does not mean that the word is not generic for said goods. The Examiner makes the argument that over time it has become generic with regard to the goods and therefore is not registrable.

Since the general public defines the term “probiotic” to refer to oral supplements that aid in digestion, the argument that the word has become so associated with soils and fertilizers to have become genericized fails. The fact that other soil and fertilizer producers have co-opted the phrase due to Applicant’s success in the industry does not render the term generic for the goods and services. Applicant has been using the mark for over ten years and has a registered California trademark for the word.

The word alone is never used to describe soil and/or fertilizers or an ingredient therein. Rather it is used to identify Applicant’s particular brand of soils and fertilizers as being “for life”.

3.5 The Examiner concludes that the proposed mark has not acquired distinctiveness.

The Examiner cites the 11 years of use in commerce as insufficient to show acquired distinctiveness.

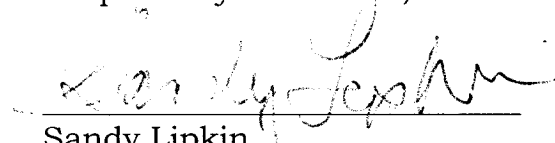
Applicant strongly disagrees with this conclusion and refers back to the marketing put into the brand over the years as well as the statement of Dr. Amaranthus about the origin of the use of the word with regard to fertilizers. Furthermore, the Examiner’s own evidence of the use of the term by others that are subsequent to Applicant’s first use for said goods argues FOR the distinctiveness of the brand and not against it in that the word was co-opted by competitors to benefit from the goodwill created by Applicant.

4.0 Conclusion.

Applicant asserts that the mark is neither generic nor descriptive in that the commonly understood definition of the word does not apply to additives to soils and fertilizers. Hence, because the definition of the word is not associated in any way with soils and fertilizers, it cannot be found to be descriptive of generic relative thereto. Furthermore, Applicant's continued use of the word with regard to soils and fertilizers has not genericized the word to the point that it has become a synonym with the goods and services. Additionally, Applicant has provided evidence that the relevant purchasing public associates the mark with Applicant's goods and that the general public as well as the sub-group of the purchasers of this class of goods has not genericized the word to define said goods.

For the foregoing reasons, the Applicant submits that the refusal by the Trademark Examining Attorney to register the Applicant's mark should be reversed.

Respectfully submitted,


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I hereby certify that this correspondence, and any attachments thereto, will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

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Signature: *Larry Leskin*